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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/994,357	11/26/2001	Douglas B. Quine	F-323	9831
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919	7590	01/14/2005
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EXAMINER

PATEL, DHAIRYA A

ART UNIT

PAPER NUMBER

2151

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/994,357		QUINE, DOUGLAS B.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Dhairya A Patel		2151	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 November 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>11/26/2002</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

1. Application # 09/ 994,357 was filed on 11/26/2001. Claims 1-4 are subject to examination.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuei et al. U.S. Patent 6,654,779 (hereinafter Tsuei) in view of Return Path, "ECOA Email change-of-address" (in IDS by Applicant) (hereinafter Return Path).

2. As per claim 1, Tsuei teaches a method for providing notification of an e-mail address change and forwarding messages to forwarding e-mail addresses, the method comprising the steps of: (column 6 lines 16-29)

-registering a plurality of subscribers for an e-mail forwarding service, the step of registering comprising: (column 10 lines 38-47)

-identifying disfavored e-mail addresses of the subscribers (Fig. 3 element 342,344) (column 10 lines 38-58)

-identifying forwarding e-mail addresses of the subscribers (Fig. 3 element 342,344) (column 10 lines 38-58)(column 6 lines 30-44)

-identifying one or more e-mail address change notification recipients; (Fig. 3 element 342,344) (column 10 lines 38-58) (column 6 lines 30-44)

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-associating the disfavored e-mail addresses with the corresponding forwarding e-mail addresses in an e-mail forwarding computer. (column 6 lines 30-44) (column 7 lines 9-24)

-providing an electronic address for receiving messages at the e-mail forwarding computer, said messages relating to any of the plurality of disfavored e-mail addresses; (column 7 lines 9-24 lines 36-43) (column 6 lines 30-44)

-receiving said messages at the electronic address (column 7 lines 9-24 lines 36-43) (column 6 lines 30-44)

-identifying, with the e-mail forwarding computer, a disfavored e-mail address in a received message, the disfavored e-mail address being other than the electronic address for the e-mail forwarding computer (column 9 lines 53-64) (column 7 lines 31-46)

-determining, with the e-mail forwarding computer, a forwarding e-mail address associated with the disfavored e-mail address; (column 9 lines 53-64) (column 7 lines 31-46) and

-forwarding at least a portion of the received message from the e-mail forwarding computer to the associated forwarding e-mail address. (column 7 lines 14-18)(column 10 lines 24-36)

Tsuei fails to teach sending a pre-generated e-mail address change notification to the identified one or more e-mail address change notification recipients; and providing a description of the e-mail forwarding service in the pre-generated e-mail address change notification. Return Path teaches sending a pre-generated e-mail

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address change notification to the identified one or more e-mail address change notification recipients (Page 2, "How ECOA works" & "The consumer experience"); and providing a description of the e-mail forwarding service in the pre-generated e-mail address change notification (Page 2, "How ECOA works" & "The consumer experience" & "The network infrastructure for high-volume address updates" & "Activating ECOA" Picture on Page 2) It would have been obvious at the time of applicant's invention to implement Tsuei's invention in Return Path's invention to come up with pre-generated e-mail address change notifications to the recipients and to provide description of the email forwarding service in the email notification. The motivation for doing so would have to notify the new e-mail address change and to advertise the email forwarding service so that more people use the email forwarding service.

3. As per claim 2, Tsuei teaches the method as recited in claim 1, but fails to teach the step of registering further comprises providing a link to a subscriber registration interface in the pre-generated e-mail address change notification. Return Path teaches the step of registering further comprises providing a link to a subscriber registration interface in the pre-generated e-mail address change notification. (Page 2, "the network infrastructure for high-volume address updates" & "Activating ECOA" & Picture on page 2). It would have been obvious at the time of applicant's invention to implement Tsuei's invention in Return Path's invention to come up with link to subscriber registration interface. The motivation for doing so would have been to advertise the email forwarding service so that more people use the email forwarding service and can click on the link to go the subscriber registration interface page.

4. As per claim 3, Tsuei teaches the method as recited in claim 1 but fails to teach the step of identifying one or more e-mail address change notification recipients further comprises selecting recipients from subscribers' e-mail address books. Return Path's teaches the step of identifying one or more e-mail address change notification recipients further comprises selecting recipients from subscribers' e-mail address books. (Page 2 "how ECOA works" & "The consumer experience") The reference teaches sending e-mail notification to friends, family, and colleagues. Since if the email forwarding service is going select recipients from the address books, and friends, family, colleagues belong to address books also so it would have been inherent that selecting recipients from email address books for sending the email address change notification notice. It would have been obvious at the time of applicant's invention to implement Tsuei's invention in Return Path's invention to come up with notifying recipients from subscriber's e-mail address books about change-of-address. The motivation for doing so would have been so that subscriber does not have individually enter all the names, and does not have to remember all the family member's email address.

5. As per claim 4, Tsuei teaches the method of claim 1, but fails to teach prior to the step of sending a pre-generated e-mail address change notification there is a step of sending a test message to confirm that the forwarding e-mail address is correct. Return Path teaches prior to the step of sending a pre-generated e-mail address change notification there is a step of sending a test message to confirm that the forwarding e-mail address is correct. (Page 2, "how ECOA works"). It would have been obvious at the time of applicant's invention to implement Tsuei's invention in Return Path's

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invention to come up with sending a test message to confirm the forwarding e-mail address change. The motivation for doing so would have been so that it confirms with the consumer of the new address and verify the new email address.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A) "System and method for electronic mail (e-mail) address management" by Tsuei U.S. Patent # 6,654,779 (hereinafter Tsuei)

B) "Return Path, ECOA Email change-of-address" in Information Disclosure Statement by Applicant

7. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the applicant (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).

8.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dhairya A Patel whose telephone number is (571) 272-4066. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DAP

  
**ZARNI MAUNG**  
**SUPERVISORY PATENT EXAMINER**